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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,762	12/12/2001	David Teegarden	83825HEC	8668

7590 06/22/2004

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EXAMINER

HESS, BRUCE H

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/020,762

Applicant(s)

TEEGARDEN ET AL.

Examiner

Bruce H Hess

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11-26-03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 7 and 9-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 7 and 9-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

1. Claims 1, 5, 7 and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent to Santo et al (USP 6,558,740).

Santo et al teach an ink jet printing method wherein the recording element comprises a support coated with an image-receiving layer containing a polymeric binder (e.g., polyvinyl alcohol) and alumina particles coated with a silane coupling agent (e.g., octadecyldimethyl [3-(trimethoxysilyl) propyl] ammonium chloride). The mixing ratio of coated alumina to binder is from 1:1 to 30:1. An undercoat can be present between the substrate and the receiving layer. The experimental modification of this prior art in order to ascertain optimum-operating conditions (e.g., determine the amount of silane coupling agent applied) fails to render applicants' claims patentable in the absence of unexpected results.

2. Claims 1, 5 and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent to Koto et al (USP 6,254,892).

Koto et al teach an ink jet printing method wherein the recording element comprises a support coated with an image-receiving layer containing a polymeric binder (i.e., polyethylene) and titania particles coated with a silane coupling agent. An undercoat containing resin and pigment can be present. The experimental modification of this prior art in order to ascertain optimum-operating conditions (e.g., determine compositional relative proportions) fails to render applicants' claims patentable in the absence of unexpected results.

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3. The relevant portions of Santo et al are in column 4, lines 3 and 4; column 5, lines 13 and 14; column 9, line 13; column 10, lines 44-46 and column 11, lines 21-24, 40 and 43. The relevant portions of Kato are column 2, lines 52 and 53; column 3, lines 25, 26 and 34-37; and column 7, lines 1, 2 and 13-15.

Any inquiry concerning this communication should be directed to Bruce Hess at telephone number (571) 272-1525.

B. Hess/dh  
June 8, 2004

A handwritten signature in black ink, appearing to read "Bruce Hess", with a stylized flourish at the end.

BRUCE H. HESS  
PRIMARY EXAMINER